

ESTTA Tracking number: **ESTTA440858**

Filing date: **11/14/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Celgene Corporation
Granted to Date of previous extension	01/25/2012
Address	86 Morris Avenue Summit, NJ 07901 UNITED STATES
Correspondence information	Camille M. Miller Cozen O'Connor 1900 Market Street IP Department Philadelphia, PA 19103 UNITED STATES cmiller@cozen.com

Applicant Information

Application No	85177077	Publication date	09/27/2011
Opposition Filing Date	11/14/2011	Opposition Period Ends	01/25/2012
Applicant	Celergen Laboratories (Suisse) Inc. Nerine Chambers, PO Box 905 Road Town, Tortola, VIRGIN ISLANDS, BRITISH		

Goods/Services Affected by Opposition


Class 005. All goods and services in the class are opposed, namely: Nutritional supplements; nutritional health supplements comprising vitamins and/or minerals, herbs, plant concentrates; nutritional supplement in the nature of protein powder; vitamin and mineral supplements; food supplements for healthcare and medical purposes; medical preparations for slimming purposes
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2379836	Application Date	01/21/1997
Registration Date	08/22/2000	Foreign Priority Date	NONE

Word Mark	CELGENE
Design Mark	
Description of Mark	NONE
Goods/Services	Class 005. First use: First Use: 1998/09/29 First Use In Commerce: 1998/09/29 pharmaceutical preparations for use in the treatment of immunological, inflammatory and neurological disorders

U.S. Registration No.	2375599	Application Date	01/21/1997
Registration Date	08/08/2000	Foreign Priority Date	NONE
Word Mark	CELGENE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1998/09/29 First Use In Commerce: 1998/09/29 pharmaceutical preparations for use in the treatment of immunological, inflammatory and neurological disorders		

U.S. Registration No.	2888517	Application Date	05/19/2003
Registration Date	09/28/2004	Foreign Priority Date	NONE
Word Mark	CELGENE		

Design Mark	<p style="text-align: center;">CELGENE</p>
Description of Mark	NONE
Goods/Services	<p>Class 001. First use: First Use: 1986/12/31 First Use In Commerce: 1986/12/31 biochemical catalysts for use in medical research; biological preparations for medical purposes, namely for use in the research of immunological, inflammatory and neurological disorders; catalysts for use in the manufacture of pharmaceuticals; chemical preparations, namely, chemical reagents for scientific purposes; enzyme preparations for industrial purposes; enzymes for industrial purposes; proteins for industrial and human consumption, namely animal proteins, genetic testing reagents for scientific laboratory use, namely, DNA probes; chemical preparations used to protect crops in the agricultural and horticultural field; medicinal and biological preparations for medical laboratory use, namely, preparations for the inhibition of gene expression working at DNA, transcription, RNA or translation processes, and modulation of immune system</p> <p>Class 005. First use: First Use: 1986/12/31 First Use In Commerce: 1986/12/31 biological preparations for medical purposes, namely for use in the treatment of immunological, inflammatory and neurological disorders; pharmaceuticals, genomic and biological agents for use in the fields of immunological, inflammatory and neurological disorders for the identification, analysis, prevention, detection, diagnosis, prognosis and treatment; biological preparations for use in medicinal tests, inoculations, and treatment of diseases, namely, immunological, inflammatory and neurological disorders and cancer; culture media, namely, tissue culture media and bacteriological culture media for medical use; medicinal and biological preparations for pharmaceutical and clinical use, namely, preparations for the inhibition of gene expression working at DNA, transcription, RNA or translation processes, and modulation of immune system</p> <p>Class 040. First use: First Use: 1986/12/31 First Use In Commerce: 1986/12/31 manufacturing pharmaceutical products for others; custom synthesis of DNA to the order and specification of others; custom manufacturing services, namely, manufacturing agrochemicals to the specification of others</p> <p>Class 041. First use: First Use: 1986/12/31 First Use In Commerce: 1986/12/31 educational classes and programs in the field of thalidomide and safety issues pertaining to thalidomide, and distribution of written materials therewith</p> <p>Class 042. First use: First Use: 1986/12/31 First Use In Commerce: 1986/12/31 research in the fields of chemicals and pharmaceuticals; product safety testing in the fields of chemicals and pharmaceuticals; research and development of new products for others in the fields of chemicals and pharmaceuticals; providing clinical laboratory testing services, namely, pharmacogenetic tests, predictive medical tests, personalized medical tests, gene sequencing-based tests and genotyping base on the assessment, development and application of genomic discoveries in the pharmaceutical, informatics and clinical diagnostic industries; providing medical and pharmaceutical research information; scientific research services; design for others in the field of DNA-based assays, DNA sequencing protocols, immunoassay and methods for drug discovery; scientific research, namely, development of pharmaceuticals or diagnostic methods for</p>

	others [; agrochemical product development for others]
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Attachments	75228384#TMSN.gif (1 page)(bytes) 75228128#TMSN.gif (1 page)(bytes) 76515116#TMSN.gif (1 page)(bytes) Notice of Opposition re CELERGEN (US Appl. No. 85177077).pdf (9 pages (103285 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Camille M. Miller/
Name	Camille M. Miller
Date	11/14/2011

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

CELGENE CORPORATION,	:	
	:	
	:	Opposition No.
	:	Serial No. 85/177,077
v.	:	
	:	
	:	Filed: November 15, 2010
CELERGEN LABORATORIES (SUISSE) INC.,	:	Published: September 27, 2011
	:	
Applicant.	:	Mark: CELERGEN
	:	

NOTICE OF OPPOSITION

Celgene Corporation (“Celgene”), a Delaware corporation, with a place of business at 86 Morris Avenue, Summit, New Jersey, 07901 (“Opposer”), believe that they will be damaged by registration of the mark CELERGEN, which is the subject of application Serial No. 85/177,077, published in the September 27, 2011 *Official Gazette*, and hereby oppose the same.

As grounds of opposition, it is alleged that:

1. Upon information and belief, the Applicant, Celergen Laboratories (Suisse) Inc. (“Applicant”), is a corporation organized in the British Virgin Islands with a principal place of business located at Nerine Chambers, PO Box 905 Road Town, Tortola, British Virgin Islands.
2. Upon information and belief, Applicant filed an application to register the mark CELERGEN for “[n]utritional supplements; nutritional health supplements comprising vitamins and/or minerals, herbs, plant concentrates; nutritional supplement in the nature of protein powder; vitamin and mineral supplements; food supplements for healthcare and medical purposes; medical preparations for slimming purposes” in International Class 5 in the United States Patent and Trademark Office on November 15, 2010.

3. The application was filed as an intent-to-use application.

4. Applicant's mark was published in the *Official Gazette* on September 27, 2011.

5. Opposer filed a ninety-day request for an extension of time on September 27, 2011 thereby granting Opposer until January 25, 2012 to file its Notice of Opposition.

6. To advertise and market its pharmaceutical products and services, since at least as early as 1987, Celgene has adopted CELGENE for pharmaceutical products, including skin products, manufacturing of pharmaceutical products, and for related educational classes and programs. This date precedes Applicant's claimed date of first use.

7. On January 21, 1997, Opposer filed an application for registration of the mark CELGENE in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq. This application was assigned Serial No. 75/228,384 and covers the use of this mark in conjunction with "pharmaceutical preparations for use in the treatment of immunological, inflammatory and neurological disorders" in Int. Class 5. The date of first use is at least as early as September 29, 1998. The Patent and Trademark Office issued Registration No. 2,379,836 on August 22, 2000. Further, the Patent and Trademark Office approved Opposer's §§ 8 and 15 affidavits on September 8, 2009. Thus, Registration No. 2,379,836 is incontestable and conclusively presumed valid and enforceable.

8. On January 21, 1997, Opposer filed an application for registration of the mark



CELGENE & Design in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq. This application was assigned Serial No. 75/228,128 and covers the use of this mark in conjunction with "pharmaceutical preparations for use in the treatment of immunological, inflammatory and

neurological disorders” in Int. Class 5. The date of first use is at least as early as September 29, 1998. The Patent and Trademark Office issued Registration No. 2,375,599 on August 8, 2000. Further, the Patent and Trademark Office approved Opposer’s §§ 8 and 15 affidavits on September 23, 2009. Thus, Registration No. 2,375,599 is incontestable and conclusively presumed valid and enforceable.

9. On May 19, 2003, Opposer filed an application for registration of the mark CELGENE in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq. This application was assigned Serial No. 76/515,116 and covers the use of this mark in conjunction with “biological preparations for medical purposes, namely for use in the treatment of immunological, inflammatory and neurological disorders; pharmaceuticals, genomic and biological agents for use in the fields of immunological, inflammatory and neurological disorders for the identification, analysis, prevention, detection, diagnosis, prognosis and treatment; biological preparations for use in medicinal tests, inoculations, and treatment of diseases, namely, immunological, inflammatory and neurological disorders and cancer; culture media, namely, tissue culture media and bacteriological culture media for medical use; medicinal and biological preparations for pharmaceutical and clinical use, namely, preparations for the inhibition of gene expression working at DNA, transcription, RNA or translation processes, and modulation of immune system” in Int. Class 5, “ biochemical catalysts for use in medical research; biological preparations for medical purposes, namely for use in the research of immunological, inflammatory and neurological disorders; catalysts for use in the manufacture of pharmaceuticals; chemical preparations, namely, chemical reagents for scientific purposes; enzyme preparations for industrial purposes; enzymes for industrial purposes; proteins for industrial and human consumption, namely animal proteins, genetic

testing reagents for scientific laboratory use, namely, DNA probes; chemical preparations used to protect crops in the agricultural and horticultural field; medicinal and biological preparations for medical laboratory use, namely, preparations for the inhibition of gene expression working at DNA, transcription, RNA or translation processes, and modulation of immune system” in Int. Class 1, “manufacturing pharmaceutical products for others; custom synthesis of DNA to the order and specification of others; custom manufacturing services, namely, manufacturing agrochemicals to the specification of others” in Int. Class 40, “educational classes and programs in the field of thalidomide and safety issues pertaining to thalidomide, and distribution of written materials therewith” in Int. Class 41, and “research in the fields of chemicals and pharmaceuticals; product safety testing in the fields of chemicals and pharmaceuticals; research and development of new products for others in the fields of chemicals and pharmaceuticals; providing clinical laboratory testing services, namely, pharmacogenetic tests, predictive medical tests, personalized medical tests, gene sequencing-based tests and genotyping base on the assessment, development and application of genomic discoveries in the pharmaceutical, informatics and clinical diagnostic industries; providing medical and pharmaceutical research information; scientific research services; design for others in the field of DNA-based assays, DNA sequencing protocols, immunoassay and methods for drug discovery; scientific research, namely, development of pharmaceuticals or diagnostic methods for others” in Int. Class 42. The date of first use is at least as early as December 31, 1986. The Patent and Trademark Office issued Registration No. 2,888,517 on September 28, 2004. Further, the Patent and Trademark Office approved Opposer’s §§ 8 and 15 affidavits on October 20, 2009. Thus, Registration No. 2,888,517 is incontestable and conclusively presumed valid and enforceable.

10. Opposer has vigorously defended the CELGENE mark against infringers and potential infringers.

11. Opposer's CELGENE mark is inherently distinctive and represents the exceedingly valuable goodwill of Opposer's pharmaceuticals, research and development, medical information and technical consultation services in connection with pharmaceuticals and drug delivery methods.

12. Opposer's CELGENE mark has become well known throughout the pharmaceutical industry. The CELGENE mark has been widely used in the manufacture and distribution of pharmaceutical products. Opposer's well-known pharmaceutical products and drug delivery compounds all bear the CELGENE mark on the packaging and in all marketing materials.

13. Through the use of the CELGENE mark, Opposer has developed an excellent reputation for research and development and commercialization of pharmaceuticals and drug delivery compounds and methods, and its medical, informational and technical consultation services related to its pharmaceuticals.

14. Opposer's products bearing the CELGENE mark are sold in many countries around the world including but not limited to the United States, Canada, the United Kingdom, and Europe. In 2010 alone, Opposer has generated over 3.625 billion in U.S. dollars in the sales of pharmaceutical products worldwide bearing the CELGENE mark. Opposer expects the worldwide sales of its pharmaceutical products bearing the CELGENE mark to reach 4.85 billion in U.S. dollars in 2011.

15. The market success of Opposer's pharmaceutical products and related services offered under CELGENE mark has been extraordinary, and the relevant public has come to rely

upon and recognized Opposer's pharmaceutical products, and medical and pharmaceutical services by the CELGENE mark. As a result, the CELGENE mark has substantial goodwill associated with it.

16. As a result of long and extensive use of the CELGENE mark by the Opposer and the market success, the CELGENE mark has become famous.

17. Since Applicant has filed an intent-to-use application, there are no specimens in the file history for Opposer to be able to determine if the appearances of the respective marks as used in commerce are similar.

LIKELIHOOD OF CONFUSION PURSUANT TO SECTION 2(d)

18. Opposer's CELGENE mark is substantially similar to Applicant's CELERGEN mark in sound, appearance, and meaning. Upon information and belief, the marks create the same commercial impression and are confusingly similar.

19. Upon information and belief, Opposer's and Applicant's respective medical, health and pharmaceutical-related goods and services, particularly Applicant's "food supplements for healthcare and medical purposes; medical preparations for slimming purposes," would be provided in related channels of trade and would be directed to the same or similar potential users of the respective goods and services.

20. Upon information and belief, the customer base of both Opposer's and Applicant's medical, health and pharmaceutical-related goods and services are similar, if not identical.

21. If Applicant is permitted to register its mark, and, thereby, obtain the *prima facie* exclusive right to use Applicant's CELERGEN mark in the marketplace, confusion is likely to result, and Opposer will be damaged thereby.

22. Applicant's use of Applicant's CELERGEN mark in connection with medical, health and pharmaceutical-related goods and services is likely to cause confusion or mistake or to deceive, within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

23. Allowance of Applicant's application and registration of the CELERGEN mark would result in damage and injury to Opposer, who has expended considerable sums and effort in promoting and developing its CELGENE mark.

DILUTION PURSUANT TO SECTION 43(C)

24. Opposer's CELGENE mark is famous.

25. Since Applicant has only filed an intent-to-use application, there is no date of constructive use of Applicant's CELERGEN mark.

26. Applicant's application was submitted on November 15, 2010, which is after Opposer's CELGENE mark became famous.

27. Applicant's use of the CELERGEN mark dilutes the distinctive quality of the CELGENE mark.

28. On information and belief, Applicant intended to trade on Opposer's reputation and/or to cause dilution of the CELGENE mark.

29. Applicant's use of its CELERGEN mark in connection with medical, health and pharmaceutical-related goods and services is likely to dilute the goodwill associated with Opposer's CELGENE mark, within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

30. Allowance of Applicant's application and registration of its CELERGEN mark would result in damage and injury to Opposer, who has expended considerable sums and effort in promoting and developing Opposer's CELGENE mark.

WHEREFORE, Opposer prays that allowance of Serial No. 85/177,077 be refused and that this Opposition be sustained.

Respectfully submitted,

Date: November 14, 2011


A handwritten signature in dark ink, appearing to read "Camille M. Miller", written in a cursive style.

Camille M. Miller
Elizabeth Lai Featherman
COZEN O'CONNOR, P.C.
1900 Market Street
Philadelphia, PA 19103
Telephone: (215) 665-2000
Facsimile: (215) 665-2013
Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on this date, I caused a true and correct copy of the foregoing Notice of Opposition to be served via e-mail and First Class Mail, postage pre-paid to counsel for Applicant:

Leigh Ann Lindquist
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
Washington, DC 20037
llindquist@sughrue.com

A handwritten signature in black ink, appearing to read "Camille M. Miller", written over a horizontal line.

Camille M. Miller

Date: November 14, 2011